

ESTTA Tracking number: **ESTTA725392**

Filing date: **02/05/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding.	92055153
Applicant	Defendant Delphix Corp.
Other Party	Plaintiff Embarcadero Technologies, Inc.
Have the parties held their discovery conference as required under Trademark Rules 2.120(a)(1) and (a)(2)?	Yes

Motion for Suspension in View of Civil Proceeding With Consent

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, Delphix Corp. hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

Delphix Corp. has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

Delphix Corp. has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Facsimile or email (by agreement only) on this date.

Respectfully submitted,

/Eric Ball/

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02/05/2016

EXHIBIT 1

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Attorneys for Plaintiff

10 DELPHIX CORP.

11
12 IN THE UNITED STATES DISTRICT COURT
13 FOR THE NORTHERN DISTRICT OF CALIFORNIA
14

15 DELPHIX CORP.,

16 Plaintiff,

17 v.

18 EMBARCADERO TECHNOLOGIES, INC.,

19 Defendant.

Case No.: 3:16-cv-00606

**COMPLAINT FOR DECLARATORY
JUDGMENT**

DEMAND FOR JURY TRIAL

1 Plaintiff Delphix Corp. (“Delphix”), for its complaint against Defendant Embarcadero
2 Technologies, Inc. (“Embarcadero”), alleges as follows:

3 **NATURE OF ACTION**

4 1. This is an action for declaratory judgment. By this action, Delphix seeks to
5 resolve a controversy with Embarcadero and to eliminate any doubt that the DELPHIX name and
6 trademarks, used in connection with Delphix’s products and services, do not infringe, dilute or
7 unfairly compete with any trademark rights in the DELPHI mark purportedly owned by
8 Embarcadero. Delphix further seeks a declaratory judgment that its Registration No. 3,768,914
9 for the DELPHIX mark is valid.

10 **THE PARTIES**

11 2. Delphix is a Delaware Corporation with its principal place of business in
12 Menlo Park, California.

13 3. Delphix believes and therefore alleges that Embarcadero is a Delaware
14 Corporation with its principal place of business in San Francisco, California.

15 **JURISDICTION AND VENUE**

16 4. Delphix brings this action pursuant to 15 U.S.C. §§ 1051, *et seq.* (the Lanham
17 Act). The Court has subject-matter jurisdiction over this action under 28 U.S.C. § 1331 (federal
18 question), 28 U.S.C. § 1338 (original jurisdiction of trademark claims), and 28 U.S.C. § 2201
19 (the Declaratory Judgment Act).

20 5. The Court has personal jurisdiction and venue is proper in this judicial district
21 pursuant to 28 U.S.C. § 1391 because: (i) a substantial portion of the events giving rise to this
22 action occurred in this judicial district, and/or (ii) Embarcadero does business in this judicial
23 district.

24 **INTRADISTRICT ASSIGNMENT**

25 6. Because this is an intellectual property case, it is subject to assignment to any
26 division pursuant to Civil Local Rule 3-2(c).

THE PARTIES' USE AND REGISTRATION OF THEIR RESPECTIVE MARKS

7. Delphix offers software used in database management. Delphix's solutions provide its customers on-demand access to data by securely "virtualizing" the customer's data. Its products and services also offer companies the ability to mask sensitive virtualized data, reducing the likelihood of a costly data breach. Delphix is a leading provider of data virtualization solutions and is recognized as a pioneer in the space.

8. Delphix uses a stylized version of its mark, which employs a distinctive font and an angular red "fin" design in place of the letter L, as shown in figure 1 below (the "DELPHIX Logo"). Delphix owns a federal registration for the DELPHIX Logo, Registration Number 3,768,914. A copy of the certificate for Registration Number 3,768,914 is attached as **Exhibit A**.



Figure 1

9. Delphix believes and therefore alleges that Embarcadero uses the DELPHI mark in connection with programming tools used to write code for software programs. Delphix believes and therefore alleges that Embarcadero's DELPHI-branded programming tools are unrelated to Delphix's data virtualization tools.

10. In contrast to Delphix's "fin" logo, Embarcadero uses a helmet logo with its DELPHI mark, which it frequently uses with a stylized version of its company mark, EMBARCADERO, as shown in figure 2 below.



Figure 2

1 11. In addition to offering substantially different products and services under notably
2 different marks, the parties sell their products to different customers through different sales
3 channels. The decision makers in the purchasing process for Delphix's products include
4 individuals like corporate chief technology officers. Delphix also sells its products after
5 negotiation and testing to customize Delphix's solutions to its customers' needs. By contrast,
6 Delphix believes and therefore alleges that Embarcadero sells its DELPHI product without any
7 negotiation or customization and that it is purchased by hobbyists and students.

8 **EMBARCADERO'S CLAIMS OF INFRINGEMENT**

9 12. Embarcadero has alleged that Delphix's DELPHIX trademark and trade name
10 infringe, dilute and unfairly compete with Embarcadero's purported rights in the DELPHI mark.
11 Additionally, Embarcadero has opposed Delphix's application to register the DELPHIX mark
12 before the Trademark Trial and Appeal Board. Embarcadero also seeks to cancel Delphix's
13 Registration No. 3,768,914 for the DELPHIX mark, again based on allegations that the
14 DELPHIX mark is likely to be confused with the DELPHI mark and the DELPHIX mark will be
15 falsely associated with Embarcadero and its purportedly famous DELPHI mark, as well as
16 allegations that Registration No. 3,768,914 is invalid.

17 **EMBARCADERO'S LIMITED RIGHTS IN THE DELPHI MARK**

18 13. Embarcadero uses the trade name EMBARCADERO, and it has never used
19 DELPHI as a trade name in the United States.

20 14. Embarcadero was not the first company to use the mark DELPHI in the United
21 States.

22 15. Embarcadero was not the first company to use the mark DELPHI in the United
23 States in connection with software or software-related products or services.

24 16. Embarcadero claims to own a single federal registration for the DELPHI
25 trademark, Registration Number 2,873,025.

17. Delphix believes and therefore alleges that it took nearly ten years for Embarcadero to obtain its claimed registration for the DELPHI mark because of conflicts with other holders of DELPHI marks.

18. Embarcadero is one of many companies using DELPHI marks in the United States. A search of the U.S. Patent and Trademark Office records for the mark DELPHI shows dozens of other registered DELPHI marks used with a variety of products and services, including marks used with software and information technology. For example, the PTO has issued registrations for the following trademarks:

Mark Category	Registration No.
Delphi Software consulting services	2728584
Delphi Software education services	1651752
Delphi Software for smartphones	4355502
Delphi Internet wireless devices	4344258
Delphi Connectors for electronic circuits	4351654
Delphi Website hosting	4401495
Delphi Transmission of data for use in telematic applications	4401494
Delphi Healthcare Management Services	3799054

Mark Category	Registration No.
Delphi Vim Software for records management	3816168
Delphi Software for use by hospital facilities	2864390

19. Embarcadero has not opposed or sought to cancel any of the registrations for any of the marks identified in paragraph 18.

20. Delphix believes and therefore alleges that Embarcadero has not challenged the use of any of the marks identified in paragraph 18.

21. Delphix believes and therefore alleges that Embarcadero's DELPHI mark has co-existed with each of the marks identified in paragraph 18 without any confusion.

22. Embarcadero's DELPHI mark is not famous among the general consuming public.

23. Embarcadero's DELPHI mark was not famous among the general consuming public in 2004.

24. Embarcadero's DELPHI mark was not famous among the general consuming public in 2005.

25. Embarcadero's DELPHI mark was not famous among the general consuming public in 2006.

26. Embarcadero's DELPHI mark was not famous among the general consuming public in 2007.

27. Embarcadero's DELPHI mark was not famous among the general consuming public in 2008.

28. Embarcadero's DELPHI mark was not famous among the general consuming public in 2009.

29. Embarcadero's DELPHI mark was not famous among the general consuming public in 2010.

1 30. Embarcadero's DELPHI mark was not famous among the general consuming
2 public in 2011.

3 31. Embarcadero's DELPHI mark was not famous among the general consuming
4 public in 2012.

5 32. Embarcadero's DELPHI mark was not famous among the general consuming
6 public in 2013.

7 33. Embarcadero's DELPHI mark was not famous among the general consuming
8 public in 2014.

9 34. Embarcadero has never used the mark DELPHIX, and it has never used the
10 stylized mark shown in Registration No. 3,768,914.

11 **THE LACK OF CONFUSION BETWEEN DELPHIX'S "DELPHIX"**
12 **MARK AND EMBARCADERO'S PURPORTED "DELPHI" MARK**

13 35. Embarcadero's purported DELPHI mark sounds nothing like Delphix's DELPHIX
14 mark. Unlike the mark DELPHI, which ends in a "fi" or "fee" sound, the DELPHIX mark ends
15 with a "fix" sound. The DELPHI and DELPHIX marks are no more similar than MA and MAX
16 or SO and SOX. The added X in the DELPHIX mark creates a substantially different sight,
17 sound and meaning.

18 36. Despite years of coexistence with Delphix, Embarcadero has no evidence of
19 confusion caused by Delphix's DELPHIX name or mark.

20 37. Embarcadero has no evidence of actual consumer confusion caused by Delphix's
21 DELPHIX name or mark in 2009.

22 38. Embarcadero has no evidence of actual consumer confusion caused by Delphix's
23 DELPHIX name or mark in 2010.

24 39. Embarcadero has no evidence of actual consumer confusion caused by Delphix's
25 DELPHIX name or mark in 2011.

26 40. Embarcadero has no evidence of actual consumer confusion caused by Delphix's
27 DELPHIX name or mark in 2012.

28

1 41. Embarcadero has no evidence of actual consumer confusion caused by Delphix's
2 DELPHIX name or mark in 2013.

3 42. Embarcadero has no evidence of actual consumer confusion caused by Delphix's
4 DELPHIX name or mark in 2014.

5 43. Embarcadero has no evidence of actual consumer confusion caused by Delphix's
6 DELPHIX name or mark in 2015.

7 **FIRST CLAIM FOR RELIEF**

8 **(Declaratory Judgment of Non-Infringement)**

9 44. Delphix incorporates by reference the previous allegations of this complaint.

10 45. Embarcadero has claimed that Delphix infringes the DELPHI trademark and has
11 demanded that Delphix cease use of its DELPHIX trade name and trademark. Because of
12 Embarcadero's actions, there is substantial controversy between the parties of sufficient
13 immediacy and reality to warrant the issuance of a declaratory judgment.

14 46. Delphix's use of its DELPHIX trademark and trade name for Delphix's products
15 and services does not overlap with Embarcadero's purported use of the DELPHI mark for
16 Embarcadero's products and services.

17 47. There is no likelihood that any relevant consumers would be confused, mistaken,
18 or deceived into believing that Delphix is affiliated, connected, or otherwise associated with
19 Embarcadero, or that Embarcadero is sponsoring or has otherwise approved of Delphix's products
20 and services as a result of the DELPHIX trademark and trade name.

21 48. The differences between the parties' trademarks and use prevent any likelihood of
22 confusion, including without limitation the dissimilarities as to appearance, sound, meaning, and
23 commercial impression of the parties' respective marks.

24 49. The parties sell their respective goods and services in different commercial
25 markets and in different channels of trade. Delphix believes and therefore alleges that customers
26 are not likely to encounter the parties' respective products and services in proximity to each other,
27 further preventing any likelihood of confusion.

28

1 50. The parties' respective customers exercise a high degree of care, further
2 preventing any likelihood of confusion.

3 51. Despite years of coexistence, there has been no actual confusion caused by
4 Delphix's trademark or trade name.

5 52. Delphix therefore requests that the Court declare that Delphix neither infringes any
6 of Embarcadero's purported trademark rights nor violates 15 U.S.C. § 1114 or the common law.

7 **SECOND CLAIM FOR RELIEF**

8 **(Declaratory Judgment of Non-Dilution)**

9 53. Delphix incorporates by reference the previous allegations of this complaint.

10 54. Embarcadero has claimed that Delphix's use of its DELPHIX name and
11 trademarks dilutes the distinctiveness of the DELPHI trademark. Because of Embarcadero's
12 actions, there is substantial controversy between the parties of sufficient immediacy and reality to
13 warrant the issuance of a declaratory judgment.

14 55. Delphix believes and therefore alleges that the DELPHI mark is not, and has never
15 been famous.

16 56. There is no likelihood that Delphix's name or trademark would cause any dilution
17 of the distinctiveness of Embarcadero's DELPHI mark. The DELPHIX name and trademarks do
18 not blur or disparage Embarcadero's purported DELPHI mark.

19 57. Embarcadero has no evidence of actual dilution caused by Delphix's name or
20 trademark.

21 58. Delphix therefore requests that the Court declare that the Delphix's name and
22 trademarks neither dilute any of Embarcadero's trademarks nor violate 15 U.S.C. § 1125(c).

23 **THIRD CLAIM FOR RELIEF**

24 **(Declaratory Judgment of No Unfair Competition/False Designation of Origin)**

25 59. Delphix incorporates by reference the previous allegations of this complaint.

26 60. Embarcadero has claimed that Delphix's use of the DELPHIX name and
27 trademarks constitutes unfair competition. Because of Embarcadero's actions, there is substantial
28

1 controversy between the parties of sufficient immediacy and reality to warrant the issuance of a
2 declaratory judgment.

3 61. Delphix's use of its DELPHIX name and trademarks for Delphix's products and
4 services does not constitute unfair competition, including a false designation of origin within the
5 meaning of 15 U.S.C. § 1125(a), unfair competition within the meaning of California Business
6 and Professions Code § 17200, or California common law of unfair competition.

7 62. There is no likelihood that any relevant consumers would be confused, mistaken,
8 or deceived into believing that Delphix is affiliated, connected, or otherwise associated with
9 Embarcadero, or that Embarcadero is sponsoring or has otherwise approved of Delphix's products
10 and services as a result of the DELPHIX trademark and trade name.

11 63. Embarcadero has no evidence of any actual confusion resulting from Delphix's use
12 of its name or trademark.

13 64. Delphix therefore requests that the Court declare that Delphix's use of its
14 DELPHIX trademark and trade name does not constitute unfair competition, including a false
15 designation of origin within the meaning of 15 U.S.C. § 1125(a), unfair competition within the
16 meaning of California Business and Professions Code § 17200, or under California common law.

17 **FOURTH CLAIM FOR RELIEF**

18 **(Declaratory Judgment that Delphix's Registration No. 3,768,914 Is Valid)**

19 65. Delphix incorporates by reference the previous allegations of this complaint.

20 66. Embarcadero has claimed that Delphix's Registration No. 3,768,914 for the
21 DELPHIX Logo should be canceled because the DELPHIX Logo mark is likely to be confused
22 with the DELPHI mark, the DELPHIX Logo will be falsely associated with Embarcadero and its
23 purportedly famous DELPHI mark, and there was fraud in applying to register Registration
24 No. 3,768,914. Because of Embarcadero's actions, there is substantial controversy between the
25 parties of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

26 67. Delphix uses the DELPHIX Logo shown in Registration Number 3,768,914 in
27 connection with the advertisement and sale of the goods and services specified in the registration.
28

1 68. There is no likelihood that any relevant consumers would be confused, mistaken,
2 or deceived into believing that Delphix is affiliated, connected, or otherwise associated with
3 Embarcadero, or that Embarcadero is sponsoring or has otherwise approved of Delphix's products
4 and services as a result of the DELPHIX Logo.

5 69. Embarcadero has no evidence of any actual confusion resulting from Delphix's use
6 of its DELPHIX Logo.

7 70. The DELPHIX Logo shown in Registration Number 3,768,914 and Delphix's
8 application to register Registration Number 3,768,914 meets the requirements of a valid mark.

9 71. On January 21, 2016, the Trademark Trial and Appeal Board granted Delphix's
10 motion for summary judgment on Embarcadero's fraud claim regarding Registration Number
11 3,768,914.

12 72. Delphix therefore requests that the Court declare that Registration No. 3,768,914 is
13 valid.

14 73. Delphix further requests the Court to declare, under Section 37 of the Lanham Act,
15 15 U.S.C. § 1119, that Delphix has the right to maintain Registration No. 3,768,914.

16 **PRAYER FOR RELIEF**

17 THEREFORE, Plaintiff Delphix prays for judgment against Embarcadero as follows:

18 A. Declaring under Section 37 of the Lanham Act, 15 U.S.C. § 1119, that Delphix has
19 the right to maintain Trademark Registration No. 3,768,914 and issuing a certified order of this
20 declaration for the Director of United States Patent and Trademark;

21 B. Declaring under Section 37 of the Lanham Act, 15 U.S.C. § 1119, that Delphix's
22 Trademark Application No. 77944256 can proceed to registration and issuing a certified order of
23 this declaration for the Director of United States Patent and Trademark;

24 C. Declaring that Delphix's use of its DELPHIX name and trademarks does not
25 infringe upon any trademark rights of Embarcadero, including Embarcadero's claimed DELPHI
26 mark;

1 D. Declaring that Delphix's use of its DELPHIX name and trademarks does not dilute
2 any trademark of Embarcadero, including Embarcadero's claimed DELPHI mark;

3 E. Declaring that Delphix's use of its DELPHIX name and trademarks does not
4 constitute unfair competition or a false designation of origin with respect to Embarcadero and
5 Embarcadero's claimed DELPHI mark;

6 F. Declaring that Delphix's use of its DELPHIX name and trademarks does not
7 violate 15 U.S.C. § 1114, 15 U.S.C. § 1125(a), 15 U.S.C. § 1125(c), California Business and
8 Professions Code § 172000, *et seq.* or the common law;

9 G. Declaring that Delphix's Registration No. 3,768,914 is valid;

10 H. An award by the Court to Delphix of its costs in this case; and

11 I. An award by the Court to Delphix of any other relief that the Court considers just
12 and proper.

13
14 Dated: February 4, 2016

FENWICK & WEST LLP

15
16 By: /s/Jedediah Wakefield
17 Jedediah Wakefield

18 Attorneys for Plaintiff
19 DELPHIX CORP.
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FENWICK & WEST LLP
ATTORNEYS AT LAW
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DEMAND FOR JURY TRIAL

Delphix hereby demands trial by jury on all issues and claims so triable.

Dated: February 4, 2016

FENWICK & WEST LLP

By: /s/Jedediah Wakefield

Jedediah Wakefield

Attorneys for Plaintiff
DELPHIX CORP.

FENWICK & WEST LLP
ATTORNEYS AT LAW
SAN FRANCISCO

EXHIBIT A

United States of America

United States Patent and Trademark Office



Reg. No. 3,768,914 DELPHIX CORP. (DELAWARE CORPORATION)
Registered Mar. 30, 2010 960 SAN ANTONIO ROAD, 2ND FL.
PALO ALTO, CA 94303

Int. Cl.: 9 FOR: COMPUTER SOFTWARE FOR USE IN DATABASE MANAGEMENT; DATABASE
MANAGEMENT SOFTWARE FOR MANAGING DATABASE STORAGE AND PROVISIONING
FUNCTIONS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

TRADEMARK
PRINCIPAL REGISTER FIRST USE 1-31-2009; IN COMMERCE 12-3-2009.

THE MARK CONSISTS OF THE STYLIZED WORD "DELPHIX" WITH ALL LETTERS BEING
BLACK EXCEPT FOR A RED FIN, REPRESENTING THE LETTER "L".

THE COLOR(S) BLACK AND RED IS/ARE CLAIMED AS A FEATURE OF THE MARK.

SN 77-649,689, FILED 1-14-2009.

EVELYN BRADLEY, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office